

claim 11 is currently before the Examiner. This is even more evident in that pending claims 14-16 all depend from claim 11.

The foregoing amendments are being made to place the application in condition for allowance. Applicants reserve the right to pursue the previously pending claims in continuing or divisional applications without prejudice or disclaimer.

Applicants respectfully request reconsideration and the timely allowance of the pending claims. A favorable action is awaited.

**Response to the objection of claims 1 and 11**

Claim 1 was objected to “for the inclusion of a colon in the third line.” Applicants assume that the Examiner objected to claim 11 for the same reason.

Applicants hereby have amended claims 1 and 11 to remove the objectionable colon. The Examiner is respectfully requested to withdraw this objection in response to the amendments.

**Response to the rejection under 35 U.S.C. § 112, second paragraph**

Claims 7-9, and claim 10 dependent thereon, were rejected under 35 U.S.C. § 112, second paragraph, purportedly because the claims were indefinite in the recitation of “derivative of” with regard to a fatty acid desaturase.

In an effort to expedite prosecution, Applicants hereby amended claims 7-9 and the Examiner is respectfully requested to withdraw the rejection in view of these amendments.

Contrary to the Examiner’s assertion, claim 10 depends directly from claim 1 and not from claims 7-9. Therefore, claim 10 has not been amended in response to this rejection.

**Response to the rejection under 35 U.S.C. § 102 (a or e)**

Claims 1, 7, 11 and 16 were rejected under 35 U.S.C. § 102(a) purportedly for being anticipated by DelBonte et al. (U.S. Patent 5,850,026).

Applicants respectfully submit that the cited patent has an issue date and a filing date which are later than the earliest priority date of the instant application. Thus, the cited patent is

not prior art under § 102 (a) or § 102 (e). The relevant dates are summarized in the following table:

Patent or Application	Issue Date	Filing Date	Priority Documents and Their Filing Dates
U.S. Patent No. 5,850,026	Dec. 15, 1998	<b>July 3, 1996</b>	Same as the filing date ( <i>i.e.</i> , July 3, 1996).
U.S. Patent Application No. 09/117,921	Not applicable.	March 4, 1999	PCT/US97/02187 – Feb. 6, 1997 U.S. Patent Application No. 08/597,313 – <b>Feb. 6, 1996</b>

Based on the Transmittal Letter filed with the application, U.S. Patent Application No. 09/117,921 claimed priority to PCT/US97/02187 under 35 U.S.C. § 371 and further claimed priority to U.S. Patent Application No. 08/597,313 under 35 U.S.C. §§ 119/365. As also indicated on the Transmittal Letter, copies of the priority documents were sent to US/DO and the specification was amended to make reference to the claimed priorities. Since the instant application has a priority filing date which is earlier than the earliest filing date of the cited patent, the Examiner is respectfully requested to withdraw the rejection.

**Response to the rejection under 35 U.S.C. § 103 (a)**

Claims 1, 7-11 and 14-16 were rejected under 35 U.S.C. § 103(a) purportedly for being anticipated by DelBonte et al. (U.S. Patent 5,850,026) taken with Cahoon et al. (PNAS USA 94:4872-4877, May 1997) and in view of Applicants' admitted state of the prior art.

As explained previously, the patent cited as the primary reference has a filing date and an issue date which are later than the priority date of the instant application. Since the secondary references do not compensate for the loss of the patent as the primary reference, the Examiner is respectfully requested to withdraw this rejection.

**Conclusion**

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request reconsideration and the timely allowance of the pending claims. A favorable action is awaited. Should the Examiner find that an interview would be helpful to further prosecution of this application, she is invited to telephone the undersigned at his convenience.


If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

The Examiner is requested to contact the undersigned if there are any outstanding issues.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS**

By:

  
Erich E. Veitenheimer, III, Ph.D.  
Reg. No. 40,420

Date: Jun 5, 2002

**MORGAN, LEWIS & BOCKIUS LLP**  
1111 Pennsylvania Avenue, NW  
Washington, D.C. 20004  
(202) 739-3000  
**Customer No. 009629**

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please cancel non-elected claims 2-6, 12-13 and 17-34.

1. A method of altering an amount of an unsaturated fatty acid in a seed of a plant comprising~~[-]~~ decreasing a fatty acid desaturase activity in the seed by genetic manipulation of ~~[at least one of]~~ a fatty acid desaturase ~~[or fatty acid hydroxylase]~~.
7. The method of claim 1, wherein said plant is transformed with a nucleic acid containing a sequence which encodes a fatty acid desaturase ~~[or derivative thereof]~~.
8. The method of claim 1 ~~[7]~~, wherein said ~~[derivative]~~ plant is transformed with a nucleic acid containing a sequence which encodes a dominant negative mutant of a fatty acid desaturase ~~[which thereby alters the amount of the unsaturated fatty acid in the seed]~~.
9. The method of claim 1 ~~7~~, wherein said ~~derivative is a~~ plant is transformed with a nucleic acid containing a sequence which encodes a mutant fatty acid desaturase in which one or more essential histidine residues have been mutated ~~[which thereby alters the amount of the unsaturated fatty acid in the seed]~~.
11. A method of altering an amount of an unsaturated fatty acid comprising~~[-]~~
  - (a) transforming a plant cell with a nucleic acid containing a sequence which encodes ~~[a fatty acid hydroxylase or a dominant negative mutant of a fatty acid hydroxylase or]~~ a dominant negative mutant of a fatty acid desaturase,
  - (b) growing a seed-bearing plant from the transformed plant cell of step (a), and

(c) identifying a seed from the plant of step (b) with the altered amount of the unsaturated fatty acid in the seed.

14. The method of claim 11, wherein said nucleic acid contains a sequence which encodes the dominant negative mutant of a fatty acid desaturase in which one or more essential histidine residues have been mutated.

15. The method of claim 11, wherein said nucleic acid contains a sequence which encodes the dominant negative mutant of a fatty acid desaturase ~~[which thereby alters the amount of the unsaturated fatty acid in the seed]~~.